

### REMARKS

Claims 11-16 are pending in the above-referenced application.

Claims 11-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,887,269 to Brunts et al. ("Bruns") in view of U.S. Patent No. 5,774,362 to Suzuki et al. ("Suzuki"). Applicant respectfully submits that the rejection should be withdrawn for the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, but the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. Applicant respectfully submits that these criteria for obviousness are not met here.

Independent claim 11 recites a navigation card for use with a key card reader of a radio receiver of a navigation system, which navigation card includes "audio data assigned to the at least one navigation destination," and "wherein the navigation card is insertable into, and read by, the key card reader of the radio receiver, the key card reader normally adapted to read a key card to establish the operational readiness of the radio receiver."

In the Office Action, it is acknowledged that the Brunts reference does not disclose or suggest storing audio data assigned to the at least one navigation destination on the memory card. The Examiner relies instead on the Suzuki reference for teaching this feature, stating that Suzuki teaches a data memory for storing various data such as intersection data, audio data, map data, etc.

It is submitted, however, that the Suzuki reference does not disclose or suggest storing audio data assigned to navigational destinations, i.e., data that describe the destination, but rather, the audio data disclosed by Suzuki include various generic audio commands from which route guidance instructions may be generated. See Suzuki, col. 5, lines 17-20. Thus, for example, the audio data according to Suzuki may provide for audio instructions such as "turn right at the next intersection" or the like. It is emphasized that such audio instruction

data do not pertain to information associated with a specific assigned navigational destination.

Furthermore, it is submitted that the requisite motivation to combine the Brunts and Suzuki references is lacking. It is clear that the Brunts reference, which refers to displaying a travel direction and distance to a destination, does not contemplate the use of audio data in connection with the display. In particular, the Brunts reference notes the relatively limited capacity of the memory cards it employs (see Brunts, col. 6, lines 58-59). Because of this limited memory capacity, Brunts teaches that each card would be limited to “a selected type of data base as for example a camping information directory . . . including alphanumeric text.” Brunts, col. 7, lines 1-2. Given the limited scope of information contained in the memory cards according to Brunts – a *plurality of cards* are required merely for the alphanumeric destination information -- there would be no motivation to provide memory intensive audio data pertaining to a navigational destination, since this would further burden the data base storage capacity of the cards. This defeats, as a matter of law, the Examiner’s asserted motivation to combine the applied references, since the proposed modification would render the invention being modified unsatisfactory for its intended purpose (in this case storage of alphanumeric data base information). See In re Gordon, 733 F.2d 900 (Fed. Cir. 1984); MPEP §2143.01.

For at least these reasons, it is submitted that the combination of Brunts and Suzuki does not render obvious the subject matter of independent claim 11 and its dependent claim 12. Since independent claims 13 and 16 recite features analogous to those of independent claim 11, it is submitted that claims 13 and 16, as well as their dependent claims 14 and 15, are likewise allowable over the references relied upon.

CONCLUSION


It is respectfully submitted that all pending claims of the present application are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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